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10/797,216	03/10/2004	Steven M. Harris	3328.001	4133

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EXAMINER	
PICH, PONNOREAY	
ART UNIT	PAPER NUMBER
2435	
MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/797,216	HARRIS, STEVEN M.	
	Examiner	Art Unit	
	Ponnoreay Pich	2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 March 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,20-22,24-27,29,30 and 33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☒ Claim(s) *4* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/5/10 has been entered.

Claims 1, 4, 20-22, 24-27, 29-30, and 33 are pending.

Response to Arguments

Applicant's arguments were fully considered, but are not persuasive. The examiner will only address arguments that are not rendered moot by applicant's amendments.

Applicant argues in the paragraph spanning page 7-8 of the remarks filed that support for new claim 33 can be found in paragraphs 40-43 and that no new matter is added. The examiner respectfully submits that the examiner has reviewed the cited paragraphs as well as the other paragraphs of the specification as originally filed and cannot find support for the limitation further recited in claim 33, thus claim 33 does in fact contain new matter.

Cited paragraph 40 refers to a type of authorization provided by a remote computer wherein the unlocking program activated upon receipt of an authorization code being passed from a program running on a website the recipient computer logs into. Paragraph 41 refers to the unlocking program sending an email to a

predetermined email account associated with the recipient's computer and determining if the email it sent is in fact contained in the recipient's computer. Paragraph 42 refers to the unlocking program constantly looking for an authorization code in the remote system and if it gets erased or not provided, the unlocking program terminates. Paragraph 43 refers to user being required to download a file which is periodically read by the unlocking program for re-authorization. Paragraph 43 also refers to the unlocking program being constructed to not only need a password, but to authorize the running of an executable embedded in the content. Nothing in any of paragraphs 40-43 nor any other paragraphs and drawings provide support for the further limitation of "wherein the unlocking program contains authorization logic that when executed by the recipient's computer causes the unlocking program to verify that it is operating on the recipient's computer that it was distributed to" as recited in new claim 33.

Regarding the rejection of the claims under 35 USC 103, applicant argues that the prior art combination used by the office does not teach or suggest "wherein the password embedded within the unlocking program is not revealed to the at least one recipient using the recipient's computer" as recited in claim 1 and "wherein the password locking the password protected content file is not revealed to a recipient viewing the password protected content file". The basis of this argument is that Martinez and McDonald teach away from such features by requiring the user know the relevant password. The examiner respectfully submits that applicant's argument does not properly reflect the scope of what is being claimed.

The password not being revealed to the recipient can refer to the password not being brought to view or shown to the recipient, not necessarily that the password is not known to the user. Figure 6 of Martinez shows his invention being used from the user's perspective. As one can see, in sub-figures (d) and (c), when using the password wallet to enter the password, the password is replaced by "********", thus the password is not revealed/shown to the user/recipient. It is further noted that the disclosure as originally filed does not necessarily limit one to interpret the word "reveal" as claimed to mean "know" with respect to the password as applicant seems to be arguing. While it is appreciated that the claims are interpreted in light of the specification, the disclosure as originally filed only discusses the password not being "revealed" to the user, as opposed to it being not "known" to the user. There is no basis in the disclosure as originally filed for the interpretation of the word “reveal” being limited to meaning “known” as applicant is arguing.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claim 33, the limitation of "wherein the unlocking program contains authorization logic that when executed by the recipient's computer causes the unlocking program to verify that it is operating on the recipient's computer that it was distributed to" does not have written support in the disclosure as originally filed.

Applicant argues in the paragraph spanning page 7-8 of the remarks filed that support for new claim 33 can be found in paragraphs 40-43 and that no new matter is added. The examiner respectfully submits that the examiner has reviewed the cited paragraphs as well as the other paragraphs of the specification as originally filed and cannot find support for the limitation further recited in claim 33, thus claim 33 does in fact contain new matter.

Cited paragraph 40 refers to a type of authorization provided by a remote computer wherein the unlocking program activated upon receipt of an authorization code being passed from a program running on a website the recipient computer logs into. Paragraph 41 refers to the unlocking program sending an email to a predetermined email account associated with the recipient's computer and determining if the email it sent is in fact contained in the recipient's computer. Paragraph 42 refers to the unlocking program constantly looking for an authorization code in the remote system and if it gets erased or not provided, the unlocking program terminates. Paragraph 43 refers to user being required to download a file which is periodically read by the unlocking program for re-authorization. Paragraph 43 also refers to the unlocking program being constructed to not only need a password, but to authorize the running of an executable embedded in the content. Nothing in any of paragraphs 40-43

nor any other paragraphs and drawings provide support for the further limitation of "wherein the unlocking program contains authorization logic that when executed by the recipient's computer causes the unlocking program to verify that it is operating on the recipient's computer that it was distributed to" as recited in new claim 33.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 20, 21, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez et al (US 7,136,490) in view of Grant McDonald ("Meet Critter: serials 2000, An interview with Critter of Serials 2000").

Claims 1 and 20:

As per claim 1, Martinez discloses distributing a password protected content file from a one or more owner's computer to the recipient's computer (col 3, lines 30-34) wherein the unlocking program (i.e. password wallet) includes logic that when executed by the recipient's computer causes the unlocking program to run separately from and monitor at least one application program (col 3, lines 62-65) and to automatically supply the password embedded within the unlocking program to the at least one application program upon the at least one application program loading the password protected

content file (col 3, lines 40-48; col 6, lines 36-54; and col 8, lines 61-67) wherein the password embedded within the unlocking program is not revealed to a recipient using the recipient's computer (col 7, lines 46-52; col 8, lines 61-67; and Fig 6). *Note in Figure 6 of Martinez, the password is replaced with "********", thus is not revealed/displayed to the recipient*.

Note that the claim language does not prohibit the supplying of the password being done automatically in response to not only the detection of the password protected content file being loaded, but also in response to detection of something else. In the case of Martinez's teachings, the password wallet automatically supplies the proper password automatically upon detection of a password protected file being loaded and upon detection of a valid master password being loaded. It would also have been obvious to modify Martinez's password wallet so that it supplied the proper password automatically upon just the detection of the password protected content file being loaded. Note that Martinez teaches that there were several prior art wherein the user does not even have to manually enter a password to load a saved password (col 2, lines 16-60). At the time applicant's invention was made, it would have been obvious to Martinez's password wallet so that it supplied the proper password automatically upon just the detection of the password protected content file being loaded for user's convenience--some users don't want to even remember a master password.

As per the limitation of distributing from one or more owner's computer to a recipient's computer an unlocking program having a password embedded within the unlocking program, the password corresponding to the password that protects the

password protected content file, McDonald discloses the limitation (see whole article regarding Serials 2000). Serials 2000 is a database of serial numbers/password for various contents which may be downloaded and it has been around since at least the year 2000.

At the time applicant's invention was made, it would have been obvious to one skilled in the art to modify Martinez's password wallet to include features from Serials 2000 such that it can be downloaded and it already had one or more passwords for various contents already embedded within it. One skilled would have been motivated to do so because it having the serial numbers/passwords of one more content already embedded within the password wallet would make it nice and easy to use as well as fulfilling various other needs (McDonald: p3, "What's the point of Serials 2000. Is it a lark, a political statement or filling a need in the internet community").

Note that while the applicant's disclosure as a whole appears to be directed towards an invention which prevents content piracy, the claim language as currently written actually also reads on an invention which is used for and encourages content piracy in a manner similar to how Serials 2000 can be used for content piracy.

Claim 20 is directed towards an unlocking program which performs the method of claim 1, thus is rejected for substantially similar reasons. Note the recipient in Martinez's invention who uses the recipient's computer also views the password protected content (col 3, lines 30-34).

Claim 21:

Martinez further discloses wherein the unlocking program includes logic to initiate the application program to cause the application program to load the password protected content file (col 7, lines 46-52 and col 8, lines 61-67).

Claim 30:

Martinez does not explicitly teach the password protected content file is characterized as a .pdf file. However, official notice is taken that password protected .pdf files were well known in the art at the time applicant's invention was made. It would have been obvious to one skilled in the art to modify Martinez's invention further such that the password protected content file is characterized as a .pdf file and Martinez's password wallet provides password to unlock .pdf files. It is obvious to do so because it would be nothing more than simple substitution of one known element (i.e. type of content protected by a password) for another to achieve predictable results.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez et al (US 7,136,490) in view of Grant McDonald ("Meet Critter: serials 2000, An interview with Critter of Serials 2000") in further view of Schreiber et al (US 6,298,446)

Claim 22:

As per claim 22, Schreiber discloses the means for preventing a screen capture representing at least a portion of the content stored in the password content file (col 2, lines 27-30).

At the time applicant's invention was made, it would have been obvious to one skilled in the art to further modify the teachings of Martinez such that it prevents a

screen capture representing at least a portion of the content stored in the password content file. One skilled would have done so because it would provide an enhanced system to protect software from rampant unauthorized copying, distribution, and use (Schreiber: col 1, lines 21-23 and col 2, lines 27-30).

Claims 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez et al (US 7,136,490) in view of Grant McDonald ("Meet Critter: serials 2000, An interview with Critter of Serials 2000") in further view of Winneg et al (US 7,069,586).

Claims 24-26 and 29:

As per claims 24-26 and 29, Martinez does not explicitly disclose wherein the unlocking program includes logic that monitors the running of at least one system administration program capable of terminating the program and automatically terminating the system administration program/the application program upon detecting the running of such system administration program and to prevent termination of a program. However, Winneg et al. discloses: *the unauthorized process list may include browser applications, applications for scheduling tasks to be performed on the computer system, and applications for managing tasks performed on the computer system, (e.g., Microsoft Task Manager). Terminating task-managing manager and task-scheduling applications prevents a process (e.g., an application) that has been scheduled to execute during execution of the first application from executing (e.g. col. 19, lines 46 - 60),* which met the claimed limitation of monitoring the running of at least one system administration program (i.e. Task Manager program) capable of terminating the program

and automatically terminating the system administration program/the application program upon detecting the running of such system administration program and to prevent termination of a program.

Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to further modify Martinez's teachings with monitoring the running of at least one system administration program (i.e. Task Manager program) capable of terminating the program and automatically terminating the system administration program/the application program upon detecting the running of such system administration program and to prevent termination of a program taught by Winneg et al. in order to provide information about the processes and programs running on a computer, as well as the general status of the computer and also to ensure unauthorized content may not be accessed *(e.g. Winneg et al., col. 2, lines 38-39 and col. 19, lines 46 -60)*

This combination would predictably result a well known computing system includes/terminates a Task Manager program provided with a Windows operating system to provide general status of a computer and ensure application security. It has been held that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does not more than yield predictable results." *KSR.*, 127 S. Ct. at 1739, 82USPQ2d at 1395 (2007) (citing *Graham*, 383 U.S. at 12).

Claim 27:

Martinez implicitly teaches wherein the unlocking program includes logic that terminates the unlocking program after the application program has been terminated

(col 3, lines 62-65). The password wallet can be implemented as a feature of the application program, thus if the application program terminates, the password wallet also terminates.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez et al (US 7,136,490) in view of Grant McDonald ("Meet Critter: serials 2000, An interview with Critter of Serials 2000") in further view of Schull (US 2002/0004785).

Claim 33:

As per claim 33, Schull discloses wherein the unlocking program contains authorization logic that when executed by the recipient's computer causes the unlocking program to verify that it is operating on the recipient's computer that it was distributed to (paragraph 27). It would have been obvious to one skilled in the art to further modify Martinez's invention according to the limitation further recited in claim 33 using Schull's teachings because it would encourage distribution of software to other machines for evaluations while at the same time encouraging serious users to register and pay for no-merely-evaluative use (paragraph 27).

Allowable Subject Matter

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base

claim and any intervening claims. Applicant should also fully review the claim for any informalities which may have inadvertently been missed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is (571) 272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ponnoreay Pich/

Primary Examiner, Art Unit 2435